

REMARKS

The prior art rejections of the remaining claims in the present application are discussed below in the same groups used in the Office Action.

Claims 14 – 22 and 24, rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,908,038 to Le (“Le ‘038”)

The rejection of claim 14, being re-written herein in independent form, is respectfully traversed. The Office Action (last paragraph on page 5) alleges that the combination including the card fitting within the footprint of the sleeve is described by Le ‘038, specifically referencing Figures 4A and 4B, and col. 8, lns. 23 – 46. Figures 4A and 4B show the sheath 39 being much shorter than the card, the sheath 39 being sized to cover only the housing 31 portion of the card and not also the USB tab 33. The text states that the “sheath 39 is sized to fit over at least a portion of a housing 31.” (Le ‘038, col. 8, lns. 24, 25.) Claim 14, on the other hand, defines a sleeve and memory card to have “relative dimensions so that the card fits within a footprint of the sleeve” when in a designated position. In the referenced Figures 4A and 4B of the Le ‘038 patent, the card cannot fit within the sheath 39 because the sheath is sized to cover only the housing 31 portion of the card.

Claims 15 – 22 and 24, being dependent upon claim 14, are believed to be patentable for the same reason as claim 14. Additionally, claim 15 has been amended to more positively define the feature of the sleeve having “a plurality of openings in a wall of the sleeve” that are positioned to expose one set of contacts of the memory card when the sleeve is in a designated position. The cited Le ‘038 patent does not show or suggest such openings in a wall of the sheath 39 through which the memory card contacts 34 or 35 can be accessed. Claims 17, 18, 19 and 24 are also dependent upon claim 15, and are thus submitted to also be allowable for including this further feature.

Claims 23, 25 – 35, 39 and 40, rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,908,038 to Le (“Le ‘038”) in view of U.S. Patent No. 6,669,487 to Nishizawa

Claim 23, dependent upon claims that are in turn dependent upon claims 14 and 15, are submitted to be patentable for reciting the relative sizes of the card and sleeve (claim 14) and the

openings in a wall thereof that expose one set of contacts on the memory card (claim 15), as discussed above. The secondary Nishizawa patent does not suggest modification of the Le '038 patent to provide either of these features in the combination claimed.

Independent claim 25 has also been amended to more clearly recite a plurality of openings in a wall of the sleeve, through which one set of contacts on the memory card are exposed when the sleeve and card are in one designated position. The cited Le '038 patent, as discussed above, does not suggest this feature. Nor does the cited Nishizawa patent disclose this. Rather, Figures 13A and 13B of the Nishizawa patent (referenced in the Office Action, p. 9, last paragraph) shows a memory card 25 being inserted into a card slot 26 of a mobile telephone or some other host device. It is respectfully submitted to be erroneous to consider the card slot 26 to be the claimed sleeve. As shown for the card slot 21 (Figure 5) on the mobile telephone 20, the card slot 26 of Figures 13A and 13B is enclosed, one side of the card slot being removed so that its internal contacts may be viewed. But even if the card slot 26 can be considered to be a "sleeve," for the purpose of argument, there is no disclosure that this "sleeve" has a plurality of openings through which the card contacts 2 are accessible. Such openings are a positive limitation of independent claim 25, which neither of the cited references suggests.

Claims 26 – 35, dependent upon claim 25, are submitted to be patentable for the same reasons. Additionally, dependent claim 34 recites another opening in the sleeve. The Nishizawa patent is cited (Office Action, p. 13, lns. 15-19) for this but Nishizawa does not describe any kind of sleeve. The card slots 21 (Figures 5 – 7) and 25 (Figures 13A-C) cannot be considered to be the claimed sleeve. And there is no opening in the described card slots that can be considered to be the additional opening of claim 34. The illustration in Nishizawa's Figures 6, 7 and 13A-B of cut-away views of the enclosed card slots cannot be considered to disclose card slots with a missing sidewall. It is clear that the card slots are being described to be enclosed.

Further, dependent claim 35 additionally recites a sleeve with a "resilient sidewall portion with a lip" that engages an end of the card to hold the two together. The Office Action (paragraph bridging pages 14 and 15) alleges that the stopping mechanism 26 of the Le '038 patent anticipates this added limitation. But the mechanism 26 is not disclosed to be resilient, an important difference in the claimed structure.

Examples of independent claim 39 are shown in Figures 6, 7 and 10 of the present application. "Mating contacts within the sleeve and on the card" (claim 39) connect the card

with the “first set of external contacts” along an edge of the sleeve. The memory card slots of the Nishizawa patent are again alleged (Office Action, pp. 15-16) to correspond to the claimed sleeves, which, as stated above, is respectfully submitted to be in error. But for the purposes of argument, assuming this to be the case, there are no external contacts on the outside of the slots, as now recited in claim 39. The combination of references does not meet all the terms of claim 39.

Claim 40, dependent upon claim 39, is believed patentable for the same reasons as claim 39.

Claims 36 – 38, rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,908,038 to Le (“Le ‘038”)

Independent claim 36, and thus also its dependent claims 37 and 38, define specific relative thicknesses of the portions of a memory card that carry the two sets of contacts. The Office Action (pages 17-19) suggests that it would have been obvious to increase the thickness of the USB plug portion by adding the shield of the USB connector standard. But reference to the USB plug shield is not understood since this is not being claimed. Furthermore, if a shield is added to the USB plug portion of the claimed memory card, the contacts would no longer be positioned on “an outside surface” as specifically claimed. Rather, the contacts would be within the shield.

It is respectfully submitted that no prima facie case of obviousness of claims 36 – 38 has been made. The cited Le ‘038 patent does not disclose the claimed relative thicknesses. The Office Action appears to be taking Official Notice of facts not in the record to somehow extend the disclosure of the Le ‘038 patent to include a thickened card portion that carries external contacts according to the USB standard. This is not a proper rejection.

Claim 41, rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,890,188 to Le (“Le ‘188”)

This rejection is respectfully traversed. The cited Le ‘188 patent does disclose memory cards with two sets of external contacts with different formats. But the Office Action (pages 4 and 5) does not point to any disclosure therein of using such a memory card to transfer data

between two hosts in the manner recited in claim 41, and none has been found. Just the fact that the memory card of the Le '188 patent has two different sets of contacts cannot anticipate use of that card in an undisclosed manner to transfer data between two hosts.

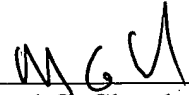
New Claims 42 – 54

New independent claims 42 and 46 are similar to claims 14 and 25, respectively, but omit the limitation of the relative sizes of the card and sleeve. They retain, however, the feature of the sleeve containing a plurality of openings through which contacts on the card are exposed when the sleeve is in one position. As discussed above, this feature is novel and renders the claims patentable. Dependent claims 43 – 45 and 47 – 54 are thus believed to be patentable for the same reason. Additionally, claim 53 adds the novel relative thickness discussed above, and claim 54 adds the resilient sleeve sidewall that engages the card to hold the two together, also as discussed above.

Conclusion

Accordingly, it is believed that this application is now in condition for allowance and an early indication of its allowance is solicited. However, if the Examiner has any further matters that need to be resolved, a telephone call to the undersigned attorney at 415-318-1163 would be appreciated.

Respectfully submitted,



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November 21, 2005
Date

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